

Attachment G

IN UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Douglas Wilson Examiner: Vinh Luong
Serial No.: 10/720,821 Art Unit: 3656
Filing Date: November 24, 2003
For: FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AFTER FINAL ACTION PURSUANT TO 37 C.F.R. §1.116

SIR:

INTRODUCTORY COMMENTS

This Amendment/Response ("Amendment") responds to the Office Action dated May 13, 2010 that finally rejected the pending claims 20-29. In this Amendment, Applicant traverses each and every basis upon which the Examiner has objected to the Specification and rejected pending claims 20-29. Accordingly, the present application is in condition for allowance:

Applicants also file herewith a Notice of Appeal.

Amendments to the Specification begin on page 2.

Amendments to the Claims are set forth in a listing of the claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 5 of this paper.

IN THE SPECIFICATION:

Please replace paragraphs [0019] and [0024] with the following amended paragraphs:

[0019] Deformable material 102 extends outward from the steering control 105 over a predetermined section of the steering control which is shown in FIG. 1 to be an arc. Deformable second section 102 may extend outwardly from the steering control at or below the inside circumference of the control over the predetermined arc. This arc will typically include at least the ten 104 and two 106 o'clock positions, or may include the entire circumference. As shown in FIG. 1, the arc that covers the ten 104 and two 106 o'clock positions is disposed on the upper one-half (½) of steering control 105.

[0024] In FIG. 2, system 202 is at or near the ten o'clock position and system 203 is shown at or near the two o'clock position. As shown in FIG. 2, system 202 that is at or near the ten o'clock position and system 203 that is at or near the two o'clock position are disposed on the upper one-half (½) of steering control 211. Although, the two systems have been described as being positioned at the ten and two o'clock locations, it is understood that they may be placed at other locations around the rim and there may be more than two systems and still be within the scope of the present invention.

IN THE CLAIMS:

Claims 1-19 (Cancelled)

20. (Previously Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

a first section that connects to an upper one-half (1/2) of a peripheral portion of the steering wheel ; and

a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

21. (Original) The apparatus as recited in claim 20, wherein the second section is deformable in at least one direction when deforming pressure is applied to such second section.

22. (Previously Amended) The apparatus as recited in claim 20, wherein the second section provides resting support for a portion of the vehicular operator's body when resting support pressure from such body portion is applied in at least one direction.

23. (Original) The apparatus as recited in claim 20, wherein the steering wheel includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

24. (Original) The apparatus as recited in claim 20, wherein the second section will return to an original first position after deforming pressure is removed therefrom.

25. (Original) The apparatus as recited in claim 20, wherein the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

26. (Original) The apparatus as recited in claim 20, wherein the first section extends a length of a predetermined peripheral portion of the steering wheel.

27. (Previously Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

at least a first first section and a second first section that connect to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

at least a first second section and a second second section that connect to, and extends from the first and second first sections, respectively, with the first and second second sections extending from the respective first and second first sections outward at an angle to a plane across a face to the steering wheel, the first and second second sections each providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section is less than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the first or second second section is equal to or greater than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel.

28. (Previously Amended) The apparatus as recited in claim 27, wherein the first and second first sections are deformable.

29. (Previously Presented) The apparatus just are cited in claim 20, wherein the first section is deformable.

REMARKS/ARGUMENTS

I. INTRODUCTION

Applicant would like to thank Examiner Luong for the telephonic interview ("Interview") conducted on May 17, 2010. In the Interview, Examiner Luong and the Undersigned reached agreement regarding the amendment to the Specification as set forth herein to traverse the Examiner's objection to the Specification. However, agreement was not reached regarding the withdrawal of the Examiner's provisional obviousness-type double patenting rejection in view of Applicant's later-filed U.S. patent application Ser. No. 10/727,306 (U.S. Pub. No. 2004/0129108) that is a continuation-in-part application of the present application. Further, the Examiner and the Undersigned did not discuss the merits of the Examiner's anticipation rejection under 35 U.S.C. §102 based on JP-H04-78769 to Shigeru ("Shigeru"). Applicant will address in detail herein the objection to the Specification and each of the two bases of rejection advanced by the Examiner.

Claims 20-29 are pending in the present application. Of these claims, claims 20 and 27 are independent claims, and the remainder of the claims, namely claims 21-26, 28, and 29, depend directly or indirectly from independent claims 20 and 27. This Amendment is being filed to respond to the Office Action dated May 13, 2010 that finally rejected the claims of the present application. In the Office Action, the Examiner set forth the following objection and rejections related to the Specification and claims:

A. The Specification was objected to for failing to provide a proper antecedent basis for the claimed subject matter, such as, "an upper one-half ($\frac{1}{2}$)" in claims 20 and 27.;

B. Claims 20-29 were rejected under 35 U.S.C. § 102(b) for anticipation based on JP-H04-78769 to Shigeru ("Shigeru");

C. Claims 20-26 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on claims 14-17, 24, and 27 of Applicant's later-filed co-pending application U.S. patent application Ser. No. 10/727,306 (U.S. Pub. No. 2004/0129108), which is a continuation-in-part application of the present application; and

D. Claims 27 and 28 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on claims 18 and 19/18 of Applicant's later-filed co-pending application U.S. patent application Ser. No. 10/727,306 (U.S. Pub. No. 2004/0129108), which is a continuation-in-part application of the present application.

Applicant will demonstrate that the Specification and claims as presented herein overcome the objection and each of the bases of rejection advanced by the Examiner, thereby, placing the present application in condition for allowance.

II. LEGAL STANDARD

As stated in Section I, the Examiner has rejected claim claims 20-29 for anticipation under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The standard for sustaining a rejection for anticipation is a single prior art reference must disclose each and every limitation of the claim. See, e.g., *Schering Corp. v. Geneva Pharma., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“[a] patent [claim] is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention; *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (“[t]o anticipate, every limitation of the claimed invention must be found in a single prior art reference, arranged as in a claim”); *Kloster Speedsteel AB v. Crucible, Inc.*, 794 F.2d 1565, 1571 (Fed. Cir. 1986) (“absent from the reference of any claimed element negates anticipation”). Shigeru does not meet this standard.

III. THE OBJECTION TO THE SPECIFICATION IS TRAVERSED

In the Office Action on page 2, the Examiner objected to the Specification for failing to provide a proper antecedent basis for the term “an upper one-half (½).” In this Amendment, Applicant has amended paragraphs [0019] and [0024] to provide written support for what is shown in Figures 1 and 2, as filed. In the Interview with Examiner Luong on May 17, 2010, the Examiner acknowledged that Figures 1 and 2 showed the disposition of the present invention at the 10 o'clock and 2 o'clock positions, and that these positions were disposed on the upper one-half (½) of the steering control 105 and 211, respectively. Accordingly, the amendments to paragraphs [0019] and [0024] were supported by Figures 1 and 2 in the application as filed and such amendments do not add new matter.

The amendments to paragraphs [0019] and [0024] traverse the Examiner's objection to Specification. Noting this, it is requested that the Examiner withdraw this objection.

IV. CLAIMS 20-29 ARE NOT ANTICIPATED BY SHIGERU

Examiner rejected claims 20-29 under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The Examiner provided a translation of Shigeru with the Office Action. The Examiner has relied on the four pages of the translation to support the anticipation rejection raised against claims 20-29. Applicant submits that Shigeru (1) teaches away from the present invention and (2) does not anticipate the present invention as the Examiner contends.

A review of the Shigeru translation teaches a support 1 that extends outward from the outer peripheral edge of a steering wheel parallel to a plane across the face of steering wheel. Support 1 is a shaped and positioned for safety reasons to have no portion extent outward from a plane across the face of the steering wheel toward the driver; however, since support 1 is wider than the steering wheel, a portion of its width is behind the plane across the back of the steering.

The support 1 is constructed of molded plastic that is covered with a layer of cushion material. The surface of the cushion material is then covered with cloth or leather. The driver's hands rest on the top of each support 1 at the outside perimeter of the steering wheel.

Each support 1 is fixedly attached to metal grooves cut at the outside periphery of the steering wheel. A latching mechanism extends through each support 1 so that when the support is positioned in the desired location along a metal groove, the latching mechanism is tightened to lock or fix the support in place. Once the support is fixed in place, it does not move until the latching mechanism is actuated to unlock it. In a second embodiment, instead of a groove being used, each support is fixed in place with a lever or nut using a band or U-shaped metal fitting, respectively. In each case, the support is fixed in place and in order to move it, the support must be unlatched, moved, and then relatched such that is fixed to the steering wheel at the new location.

The underlying molded plastic structure of support 1 is made from a light-weight plastic. This light-weight plastic is a rigid material. In order to protect a driver from contacting this rigid structure in an accident, the support is specifically placed such that the driver would come in contact with the steering wheel before the support. To the extent that the driver comes in contact with the support in normal use, the driver would contact the cloth or leather covering the cushion

material, which reduces slippage. The following from pages 2-4 of the Shigeru translation supports Applicant's understanding of Shigeru:

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and fixed to a free place by the action of lever 5 and metal fitting 6 to make the hands stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it....*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.* [Emphasis Added.]

Examiner provided an Appendix with the Office Action in which he marked-up Figures 1, 2 and 4 of Shigeru to attempt to show the features of the present invention. Applicant contends that these figures along with this remainder of the figures clearly show Shigeru (1) teaches away from the present invention, and (2) does not teach or suggest the present invention for the same reasons the Board of Patent Appeals and Interferences ("Board") found in its decision dated August 31, 2009 that the present invention was not anticipated by U.S. Patent No.

2,118,540 to Van Arsdel ("Van Arsdel") or U.S. Patent No. 1,575,828 to Laubach ("Laubach").¹

Initially, it is noted in Figures 1 and 4 of Shigeru that support 1 extend outward from the outer edge of the periphery of the steering wheel parallel to a plane across the face of the steering wheel and because support 1 is thicker than the steering wheel, a portion of support 1 protrudes behind a plane across the back of the steering wheel. No portion of support 1 extends in front of a plane across the face the steering wheel for safety reasons. This is supported at pages 3-4 of the Shigeru translation, where it states:

Support 1 does not come into contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of the steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.

As demonstrated in the quotations above from Shigeru, support 1 extends outward in the plane of the steering wheel with a portion behind that plane. Further, as a safety factor, support 1 never extends in front of the plane across the face of the steering wheel toward the driver. Therefore, noting these features of Shigeru, this reference teaches away from the present invention as claimed in independent claims 20 and 27 in which the fatigue relieving/preventing apparatus extends outward from the steering wheel toward the driver.

Claims 21-26 and 29 depend from claim 20, and claim 28 depends from claim 27. Since claims 21-26 and 29 depend from claim 20, each of these dependent claims includes all the features of claim 20. Further, since claim 28 depends from claim 27, it will include all the features of claim 27. Given this, Shigeru teaches away from claims 21-26 and 29, and 28 for the same reasons that it teaches away from the independent claims from which each of these dependent claims depend.

A review of Shigeru also supports that this reference does not teach or suggest at least the following feature of independent claims 20 and 27 of the present application:

the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate

¹ The decision of the Board of Patent Appeals and Interferences dated August 31, 2009 is attached as Attachment 1.

the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

As noted previously, Applicant submits that support 1 of Shigeru, although being constructed of a light-weight plastic, is a rigid structure that is fixed to the steering wheel and is not "deformable out interference with vehicular operator's ability to operate the steering wheel" as set forth in claims 20 and 27. Applicant further submits, given the rigid structure of support 1 and its fixing to the steering wheel by either (1) lever 5 with metal fitting 6 disposed in groove 7, or (2) a lever and band 11, or (3) a nut and U-shaped metal fitting 12, it is cumulative with Van Arsdel and Laubach, and, as such, independent claims 20 and 27 are patentable over Shigeru.

In overturning the Examiner's anticipation rejection under 35 USC §102 based on Van Arsdel and Laubach, the Board stated the following regarding these two references. First, with regard to Van Arsdel, the Board stated:

Van Arsdel

5. The Examiner finds from Van Arsdel's disclosure (page 1, right column at line 49 to page 2, left column at line 2 and at lines 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 9-10). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference.
6. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, page 2, left column at lines 28-32) to find that an Arsdel's grip-rest 2 is deformable does not in fact support the Examiner's finding. Instead, this portion of Van Arsdel supports a finding that to move the grip-rest 2, the screw 14 must be loosened, the rest repositioned, and screw 14 tightened. The Appellant argues that this operation is not deforming according to claim 20 during normal use of the second section (grip-rest) (parenthetical nomenclature to Van Arsdel). The Appellant argues, instead, once positioned, the grip-rest is fixed. App. Br. 8.

(Board Decision, pp. 7-8)

Anticipation with Van Arsdel

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 6) and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 7). A structure, as the Examiner has found, see Fact 5, that requires disassembly and reassembly and permits the driver to push against cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed.* Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 20-26 and 28/20. [Emphasis Added.]

(Board Decision, p. 13)

Now, with respect to Laubach, the Board stated:

11. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 12.
12. The Appellant argues that:

The description of the knobs and a review of the Figures... [make] plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 20. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Moreover, if the driver were to attempt to grab the steering wheel at the locations of the knobs in an emergency, the knobs would not deform and would prevent the driver from grabbing the wheel at these knob locations. Therefore, Laubach does not support a

prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs. [Emphasis in original.]

See e.g., page 1, lines 43-71. App. Br. 11-12.
(Board Decision, pp. 10-11)

Anticipation with Laubach

We conclude that Appellant has met his burden in showing that *Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel* when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. See Facts 11 and 12. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device.* As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 20, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess the capability of deforming as set forth in claim 20. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 20, 27, 28/20, and 28/27. [Emphasis Added.]

(Board Decision, pp. 15-16)

In the citations to the Board Decision above, it is plain that a structure in which a rigid support is fixed to the steering wheel and can only be repositioned by detaching the rigid structure and reattaching it at a different location does not anticipate claims 20 and 27 of the present invention. Applicant submits that Shigeru is like Van Arsdel and Laubach in this regard and, therefore, does not anticipate claims 20 and 27.

For convenience, Applicant again provides the following portion of the Shigeru translation (Shigeru, pp. 2-4):

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and fixed to a free place by the action of lever 5 and metal fitting 6 to make the hands stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it. When the driver thinks that the change is unnecessary, he/she draws the lever 5 to the upper part of steering wheel 2 having a metal fitting inlet/outlet 4 to make it possible to freely remove the metal fitting.

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.* [Emphasis Added.]

Applicant's contention molded part 8 of light-weight plastic as shown in Figure 3 of Shigeru is a rigid structure is supported by the translation. Figure 3 shows molded part 8 covered with cushion material 9 and cloth or leather covering 10. Molded part 8 also includes groove 7 into which lever 5 is set. Lever 5 and metal fitting 6 are connected by a connecting rod (Figure 6).

When the driver fixes molded part 8 to the steering wheel, the connecting rod between lever 5 and metal fitting 6 is disposed through the hole in molded part 8 that extends from groove 7 to the inside surface of molded part 8. In order to fix molded part 8 to the steering wheel, there must be considerable fixing tension applied using lever 5 and metal fittings 6. If molded part 8 was not made of a rigid material, support 1 would (1) collapse under this fixing tension and (2) would not be fixed in place and not movable from that place until the fixing

tension was removed as specified in the translation. Further, the translation is explicit that in order to move support 1 from one place to another, it must be unfixed moved and refixed to the steering wheel by operation of lever 5, metal fitting 6, and groove 7. As such, support 1 is a rigid structure covered with cushion material and cloth or leather.

The rigid support structure and method of moving it as disclosed in Shigeru is exactly what the Board has held is not “deforming out of interference with the vehicular operator’s ability to operate the steering wheel when pressure from the portion of the vehicular operator’s body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel” according to claims 20 and 27 of the present invention in its holding that neither Van Arsdel nor Laubach anticipate these claims. Accordingly, it is improper for the Examiner to disregard the Board’s explicit prior holding on this issue.

Noting the foregoing, Applicant has provided at least two grounds that clearly show that Shigeru does not anticipate independent claims 20 and 27 of the present application. The first is Shigeru teaches away from the invention of claims 20 and 27, and the second is Shigeru does not anticipate claims 20 and 27 for the same reasons that the Board found Van Arsdel and Laubach do not anticipate these claims.

Claims 21-26 and 29 depend from claim 20, and claim 28 depends from claim 27. Since claims 21-26 and 29 depend from claim 20, each of these dependent claims include all the features of claim 20. Further, since claim 28 depends from claim 27, it will include all the features of claim 27. Given this, Shigeru fails to anticipate claims 21-26 and 28 for the same reasons that it fails to anticipate the independent claims from which each of these dependent claims depend.

Applicant’s positions above make plain that he has traversed the Examiner’s anticipation rejection raised against claims 20-29 based on Shigeru and Applicant requests that this rejection be withdrawn.

V. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION IS IMPROPER

The Examiner provisionally rejected claims 20-26 under the judicially created doctrine of obviousness-type double patenting in view of claims 14-17, 24, and 27 of Applicant’s later-filed co-pending application U.S. patent application Ser. No. 10/727,306 (U.S.

Pub. No. 2004/0129108) ("the '306 application") that is a continuation-in-part application of the present application. Further, the Examiner provisionally rejected claims 20 and 28 under the judicially created doctrine of obviousness-type double patenting in view of claims 18 and 19/18 of the '306 application. Applicant submits that in light of the filing of the Terminal Disclaimer in the '306 application, the Examiner's provisional obviousness-type double patenting rejections in the present application are improper and should be withdrawn.

In the May 17th Interview, when the Undersigned queried the Examiner about the provisional rejections advanced in the present application, the fact that a terminal disclaimer had been filed and accepted in the '306 application was acknowledged by the Examiner. The Undersigned also queried what the ultimate result would be if a terminal disclaimer was filed in the present application directed to the '306 application,² and both the present application and the '306 application should issue as patents. The Examiner responded that each patent would indicate it was subject to a terminal disclaimer, i.e., (1) the patent issuing from the present application would indicate a terminal disclaimer naming the '306 application and (2) the patent issuing from the '306 application would indicate a terminal disclaimer naming the present application. The Undersigned indicated to the Examiner that he believed this would be improper; however, the Examiner just pointed to MPEP §804, subsection I.B.1. as supporting his position. Applicant submits that following MPEP §804, subsection I.B.1., the filing of the Terminal Disclaimer in the '306 application overcomes any need to raise an obviousness-type double patenting rejection in view of the '306 application.

Applicant believes that the second paragraph of MPEP §804, subsection I.B.1. should apply to the present application and the co-pending '306 application regarding the filing of a terminal disclaimer. The second paragraph of MPEP §804, subsection I.B.1. states:

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer,

² A copy of the Terminal Disclaimer filed in the '306 application is attached at Attachment 2.

while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Under present facts, the present application was filed on November 24, 2003 and the '306 application, which is a continuation-in-part application of the present application, was filed on December 3, 2003. This makes the present application the earlier-filed application and the '306 application the later-filed application. In the '306 application, the Examiner raised an obviousness-type double patenting rejection in view of the claims of the present application. To overcome that rejection, Applicant filed a Terminal Disclaimer (Attachment 2), which the Examiner has acknowledged traversed that obviousness double patenting rejection in the '306 application.

MPEP §804, subsection I.B.1. addresses the situation in which there are obviousness-type double patenting rejections into applications. However, under the present facts, the obviousness-type double patenting rejection in the '306 has been overcome by the filing of a Terminal Disclaimer. This satisfies the requirement of the second paragraph of MPEP §804, subsection I.B.1. quoted above and makes it improper to raise an obviousness-type double patenting rejection in the present application, which is the early-filed application.

Noting the foregoing, Applicant has traversed the Examiner's obviousness-type double patenting rejection as it has been applied to the present application and requests that it be withdrawn.

VI. CONCLUSION

Claims 20-29 are pending in the present application. In the May 13, 2010 Office Action, the Examiner objected to the Specification; rejected claims 20-29 under 35 U.S.C. § 102(b) for anticipation based on Shigeru; and rejected claims 20-28 under the judicially created doctrine of obviousness-type double patenting in view of Applicant's later-filed co-pending '306 application that is a continuation-in-part application of the present application. In the foregoing, Applicant has traversed the objection and rejections advanced by the Examiner. Accordingly, Applicant requests that the objection to the Specification, anticipation rejection, and obviousness-type double patenting rejections be withdrawn. Noting this, the present application is condition for allowance.

The present invention is new, not obvious, and useful. Reconsideration and allow of the claims are respectfully requested and the application be passed issue in due course.

Applicant has also filed a Notice of Appeal and the appropriate filing fee.

Applicant believes no other fee is due for this Amendment. However, if a fee is due, please charge our Deposit Account No. 08-0219, under Order No.: 0114089.120US2 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: May 20, 2010

/Wayne M. Kennard
Wayne M. Kennard
Registration No.: 30,271
Attorney for Applicant(s)

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
617-526-6000 (telephone)
617-526-5000 (facsimile)

ATTACHMENT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,821	11/24/2003	Douglas B. Wilson	114089.120	5355

23483 7590 09/02/2009
WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3656

NOTIFICATION DATE DELIVERY MODE

09/02/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.mathews@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS B. WILSON

Appeal 2009-005608
Application 10/720,821
Technology Center 3600

Decided: August 31, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Douglas B. Wilson (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 20-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Appellant's counsel presented oral arguments on August 13, 2009.

THE INVENTION

The invention is to a hand and arm rest or support that prevents or lessens the amount of fatigue that occurs in the hand and arms from driving or steering a vehicle or vessel over an extended period.

Claim 20, reproduced below, is representative of the subject matter on appeal.

20. A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

a first section that connects to a peripheral portion of the steering wheel; and

a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel, the second section for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and *deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second*

*section is equal to or greater than the pressure for
deforming the second section out of interference
with the vehicular operator's ability to operate the
steering wheel.*

(App. Br., Claims App'x.; emphasis added.)

THE PRIOR ART

The Examiner relies upon the following as evidence of
unpatentability:

Laubach	US 1,575,848	Mar. 9, 1926
Van Arsdel	US 2,118,540	May 24, 1938
Anson	US 2,134,020	Oct. 25, 1938

THE REJECTIONS

The following Examiner's rejections are before us for review:

Claims 20-26 and 28/20 are rejected under 35 U.S.C. § 102(b) as
being anticipated by Van Arsdel.

Claims 20-26 and 28/20 are rejected under 35 U.S.C. § 102(b) as
being anticipated by Anson.

Claims 20, 27, 28/20, and 28/27 are rejected under 35 U.S.C. § 102(b)
as being anticipated by Laubach.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

ISSUES

The issues before us are:

Whether the Appellant has demonstrated error in the Examiner's rejection of claims 20-26 and 28/20 as being anticipated by Van Arsdell. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because Van Arsdell explicitly discloses that the driver may remove and then reattach in another location the grip rest, this operation reads on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

Whether the Appellant has demonstrated error in the Examiner's rejection of claims 20-26 and 28/20 as being anticipated by Anson. This issue turns on whether the Appellant has shown that the Examiner erred in finding that Anson's explicit disclosure that the grip portion being made from a pliable and semi-rigid material permits this structure to read on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

Whether the Appellant has demonstrated error in the Examiner's rejection of 20, 27, 28/20, and 28/27 as being anticipated by Laubach. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because a vehicle operator could unscrew Laubach's knobs and fasten the knobs to another position, this permits this structure to read on capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellant does not contest the Examiner's finding that Van Arsdel, Anson, and Laubach disclose a first section that connects to a peripheral portion of a steering wheel. App. Br. and Reply Br., *passim*.
2. The Appellant does not contest the Examiner's finding that Van Arsdel, Anson, and Laubach disclose a second section that connects to, and extends from, the first section. App. Br. and Reply Br., *passim*.

3. The Appellant does not contest the Examiner's finding that Anson's, and Laubach's second section is for supporting a portion of a vehicular operator's body when pressure from the operator's body portion is less than the pressure needed to deform the second section. App. Br. and Reply Br., *passim*. Van Arsdel discloses as its objective to provide a second section (grip-rest 2)¹ to an automobile steering wheel which will support the thumb and fingers and keep the hand in a proper steering position (comfortable for his thumb and fingers and which will keep the hand in a proper steering position). (Page 1, left column, lines 1-5). Additionally, Van Arsdel discloses that

[t]he weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest ... or with the ball of the thumb seated in the concavity as shown [in the figure] ... and the two operational positions afford opportunity for change which will keep the hand and arm from the cramp or strain from long driving.

- (Page 1, right column, lines 41-48). An device that has as its objective and is disclosed to comfortably support the hand and arm would not deform under pressure that is needed to deform such an device. As such, we find that Van Arsdel explicitly disclose its second section (grip-rest 2) is for supporting a portion of a vehicular operator's body when pressure from the operator's body portion is less than the pressure needed to deform the second section.
4. As such, we find that each of Van Arsdel, Anson, and Laubach, explicitly discloses

¹ Parenthetical nomenclature, Van Arsdel.

[a] fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising: a first section that connects to a peripheral portion of the steering wheel; and a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, ... the second section for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel . . .

See Claim 20, supra.

Van Arsdel

5. The Examiner finds from Van Arsdel's disclosure (page 1, right column at line 49 to page 2, left column at line 2 and at lines 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 9-10). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference.
6. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, page 2, left column at lines 28-32)

vehicular operator is operating the steering wheel. Ans. 5 and 10. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference.

9. The Appellant cites to Anson, page 1, left column, lines 6-25 and right column, line 49 to page 2, left column line 18, to counter the Examiner's findings. Appellant then argues, based on the citation and quoted Anson passages:

when the Anson handgrip is in use, it is in the pendant position below the steering wheel and is used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendant-hanging handgrip would not be deformed as set forth in claim 20 because it would not be in use at all.

App. Br. 10.

10. In responding to the Examiner's finding that movement of the steering wheel attachment provides further reason to find the attachment is capable of deforming out of interference, the Appellant argues:

when the handgrip is moved to the top, it is moved there to be placed purposefully out of use all the time. If the handgrip is moved to the top of the steering wheel, as suggested by the Examiner, it would be awkward and dangerous to use for driving because the driver's hands would be disposed through the steering wheel. In this position, it also would not provide any of the

benefits recited in Anson to relieve fatigue in the arms and hands of the driver. In order to move the handgrip, it would be understood that the vehicle would have to be stopped, the handgrip detached and repositioned at the top, and reattached.

App. Br. 10.

Laubach

11. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 12.
12. The Appellant argues that:

The description of the knobs and a review of the Figures makes plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 20. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Moreover, if the driver were to attempt to grab the steering wheel at the locations of the knobs in an emergency, the knobs would not deform and would prevent the driver from

grabbing the wheel at these knob locations.
Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs.

See e.g., page 1, lines 43-71. App. Br. 11-12.

PRINCIPLES OF LAW

A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

"A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

... where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of

the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

ANALYSIS

Appellant does not separately argue the claims in each ground of rejection. *See* App. Br. 6-12. We select independent claim 20 as the representative claim for deciding whether the Appellant has demonstrated error in the rejections set forth by the Examiner. *See* 37 C.F.R.

§ 41.37(c)(1)(vii) (2008). Accordingly, the dependent claims also rejected under each ground of rejection will stand or fall with claim 20 for each rejection.

We find that the prior art used by the Examiner explicitly discloses a fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising a first section that connects to a peripheral portion of the steering wheel and a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, where the second section is for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *See* Facts 1-4. The issue becomes whether the Appellant has shown error in the Examiner's finding that structures explicitly described in the prior art can satisfy the functional aspect of the second section being able to deform out of interference with the vehicular operator's

ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. Below we address whether the Appellant has shown error in the Examiner's rejection with respect to this issue for each piece of prior art.

Anticipation with Van Arsdel

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 6) and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 7). A structure, as the Examiner has found, *see* Fact 5, that requires disassembly and reassembly and permits the driver to push against cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed. Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of the performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 20-26 and 28/20.

Anticipation with Anson

We conclude that Appellant has not met his burden in showing that Anson's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. The Examiner has clearly found that Anson prefers to use a pliable and semi-rigid composition to form the grip portion 11 that the Examiner is utilizing to read on the second structural aspect. *See* Fact 8. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference. *See id.* The amount of deformation out of interference would be dependent upon the resilience property of the cured rubber and not its form. Appellant tries to show Anson does not inherently possess the characteristic of deforming out of interference because the grip would either not be used in operation (Fact 9), would be dangerous to operate, or would not achieve the recited benefits (Fact 10). Neither argument outweighs the explicit disclosure that Anson's device is manufactured from a material that is pliable and semi-rigid and thus would have an inherent property of being deformable. In this case, the Examiner has good reason (Fact 8) to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, may, in fact, be an inherent characteristic of Anson's steering attachment. In such a case, the Appellant must provide evidence that Anson's steering attachment is not capable of deforming out of

interference. *See Swinehart*, 439 F.2d at 212. Arguments that focus on a particular envisioned use of a device in a particular driving condition is not evidence that the device is not inherently capable of deforming out of interference. As such, Appellant has not met his burden of showing Anson's steering attachment is not capable of deforming out of interference as set forth in claim 20. Claims 20-26 and 28/20 fall with claim 20.

Anticipation with Laubach

We conclude that Appellant has met his burden in showing that Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. *See* Facts 11 and 12. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device. As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 20, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess

the capability of deforming as set forth in claim 20. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 20, 27, 28/20, and 28/27.

CONCLUSIONS

Appellant has met his burden of showing that the structures in Van Arsdel and Laubach are not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

Appellant has not met his burden of showing that the steering wheel attachment disclosed in Anson is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

DECISION

The Examiner's decision to reject claims 20-26 and 28/20 as being anticipated by Van Arsdel is reversed.

The Examiner's decision to reject claims 20-26 and 28/20 as being anticipated by Anson is affirmed.

Appeal 2009-005608
Application 10/720,821

The Examiner's decision to reject claims 20, 27, 28/20, and 28/27 as being anticipated by Laubach is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Klh

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

ATTACHMENT 2

TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION	Docket Number (Optional) 0114089.00121US1
-----------------------------------------------------------------------------------------------------------------------	-----------------------------------------------------

In re Application of: **Douglas B. WILSON**

Application No.: **10/727,306-Conf. #5202**

Filed: **December 3, 2003**

For: **FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE**

The owner, Douglas B. WILSON, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/720,821, filed on November 24, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for end during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that any such patent granted on the pending reference application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 30,271

/Wayne M. Kennard/ September 24, 2009
 Signature Date
Wayne M. Kennard
 Typed or printed name
(617) 526-6000
 Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
 Form PTO/SB/96 may be used for making this statement. See MPEP § 324.